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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,847	09/27/2000	Yoichi Okano	FQ5-488	6526

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EXAMINER
JAMAL, ALEXANDER

ART UNIT	PAPER NUMBER
2643	6

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/669,847	Applicant(s) OKANO, YOICHI	
	Examiner Alexander Jamal	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *27 September 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Content of Specification

1. Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive.

2. Applicant's title is objected to as not sufficiently descriptive enough. The title should read "Telephone Apparatus and Alert Method for Reminder to Return Calls".

Appropriate correction required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims **1,6,18** rejected under 35 U.S.C. 102(b) as being anticipated by Shaffer et al (6477374).

a. Claim 1: Shaffer discloses a communications system with an alert method in which:

i. A caller (person to communicate with) calls a user and the time of the call is stored along with the caller's name in a database (Caller-ID) (Col 8, lines 24-35), and (Col 12, lines 43-49).

ii. A predetermined time interval is chosen relative to the last call made by the caller (Col 16, lines 47-65).

iii. After the time interval has elapsed, the system will alert the caller (or user), and the caller (or user) may try another phone call (Col 16, line 66 thru Col 17, line 19).

b. Claim 6: The predetermined time interval is arbitrarily determined by either the user or caller (Col 16, line 66 thru Col 17, line 19).

c. Claim 18: Shaffer discloses a communications system with a:

i. Claim 18a: Database that stores the name and time data of a person to be called in a database (Caller-ID) (Col 8, lines 24-35), and (Col 12, lines 43-49).

ii. Claim 18b: Controller that determines that a time interval has elapsed without communication, then alerts the caller (or user)(Col 16, line 66 thru Col 17, line 19).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims **2,7,15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al (6477374) as applied to Claim 1, and further in view of Villa-Real (4481382).

a. Claim 2: Shaffer discloses applicant's claim 1, but does not mention that the time data is a last communication time of day which communication was made with a person to be called last.

Villa-Real teaches that communications equipment with the ability to provide an audio-visual alert system for calls to be made at specific times and dates can be a very useful tool for the professional as well as the general public. This system gives the advantage of allowing the user to schedule multiple phone calls without running the risk of forgetting them. In his reminder system, Villa-Real further specifies that the time data stored with each person's name is a last communication time of day which communication was made with a person to be called last (Col 4, lines 12-24).

It would have been obvious to one of ordinary skill in the art at the time of this application to provide the call reminder function in his communication system, and also that the stored time data is a last communication time of day which communication was made with a person to be called last.

b. Claim 7: Shaffer discloses applicant's claim 1, but does not disclose the exact method of alerting the user.

Villa-Real's system teaches a communications reminder system in which all alerts are performed by a speaker, or shown on a digital display. (Col 5, lines 60-64), (Col 1 lines 55-60).

It would have been obvious to one of ordinary skill in the art at the time of this application to provide an audio/visual alert to the user for a communications reminder system.

c. **Claim 15**: Shaffer discloses applicant's claim 1, but does not specify that All persons targeted for alert are stored on a menu in the device and output to a display so that a number may be selected, and a call made.

Villa-Real teaches that many phones today have no second or third use, and also that many people have a need for a compact, carry-along device with multiple uses at an economical price (Col 1, lines 40-47). One of the additional functions that Villa-Real implements is an automatic-dialing-after alert feature in which all persons targeted for alert are stored on a menu in the device and output to a display so that a number may be selected, and a call made (Col 11 lines 48-61), (ABSTRACT).

It would have been obvious to one of ordinary skill in the art at the time of this application to implement a feature in which all persons targeted for alert are stored on a menu in the device and output to a display so that a number may be selected, and a call made.

7. **Claims 3-5** rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al (6477374) as applied to Claims 1 and 2 and further in view of Villa-Real (4481382).

a. **Claim 3**: In order to determine if a time interval had elapsed it would be obvious to:

i. Read current time of day from a timer

ii. Calculate the elapsed time from the last communication time of day to the current time of day

iii. Determine whether the elapsed time exceeds the time interval

b. Claim 4: Shaffer et al (6477374) and Villa-Real (4481382) teach the applicant's claims 1 and 2, but Shaffer does not mention that the last communication time of day is initially set when data related to the person to be called is registered into the database.

Villa-Real (4481382) teaches a communications system where the last communication time of day is initially set when data related to the person to be called is registered into the database (ABSTRACT).

It would have been obvious to one of ordinary skill in the art at the time of this application to implement a feature in a callback reminder system whereby the last communication time of day is initially set when data related to the person to be called is registered into the database.

c. Claim 5: Shaffer et al (6477374) and Villa-Real (4481382) teach the applicant's claims 1 and 2, but Shaffer does not mention that the last communication time of day is updated each time after the communication with the caller is terminated.

Villa-Real (4481382) teaches a communications system where the last communication time of day is updated each time after the communication with the caller is terminated (Col 4, lines 16-24).

It would have been obvious to one of ordinary skill in the art at the time of this application to implement a feature in a callback reminder system whereby the last communication time of day is updated each time after the communication with the caller is terminated.

8. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al (6477374), and further in view of Smith (5822400).

Shaffer discloses a communications system that follows these steps:

a. Claim 8a: Storing the name and last communication time data of a person to be called in a database (Col 8, lines 24-35), and (Col 12, lines 43-49).

b. Claim 8c: A predetermined time interval is chosen relative to the last call made by the caller (Col 16, lines 47-65).

c. Claim 8d: Determining whether the before-alert time interval has elapsed (Col 16, line 66 thru Col 17, line 19).

d. Claim 8e: After the time interval has elapsed, the system will alert the caller (or user), and the caller (or user) may try another phone call (Col 16, line 66 thru Col 17, line 1).

But Shaffer does not mention:

e. Claim 8b: dividing the plurality of persons into a plurality of groups.

f. Claim 8c: determining the before-alert time interval for each group.

Smith (5822400) teaches that many businesses and customer service organizations utilize telephone systems that include the ability to process a large number of customer records by grouping them together into campaigns (Col 1, lines 11-36). It would have been obvious to one of ordinary skill in the art at the time of this application to divide the plurality of people into a plurality of groups and then determine the before-alert time interval for each group because this

would gives the system the advantage of being able to process the grouped users in a batch and enter account records (such as the before-alert time interval) much more efficiently.

9. Claims 9,10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al (6477374) and Smith (5822400) as applied to Claim 8, and further in view of Villa-Real (4481382).

a. Claim 9: Shaffer and Smith disclose applicant's claim 8, but do not mention that the last communication time of day is initially set when data related to the person to be called is registered into the database (ABSTRACT).

Villa-Real (4481382) teaches a communications system where the last communication time of day is initially set when data related to the person to be called is registered into the database (ABSTRACT).

It would have been obvious to one of ordinary skill in the art at the time of this application to implement a feature in a callback reminder system whereby the last communication time of day is initially set when data related to the person to be called is registered into the database.

b. Claim 10: Shaffer and Smith disclose applicant's claim 8, but do not mention that the last communication time of day is updated each time after the communication with the caller is terminated.

Villa-Real (4481382) teaches a communications system where the last communication time of day is updated each time after the communication with the caller is terminated (Col 4, lines 16-24).

It would have been obvious to one of ordinary skill in the art at the time of this application to implement a feature in a callback reminder system whereby the last communication time of day is updated each time after the communication with the caller is terminated.

c. Claim 16: Shaffer and Smith disclose applicant's claim 8, but do not mention the feature where all persons targeted for alert are stored on a menu in the device and output to a display so that a number may be selected, and a call made.

Villa-Real teaches that many phones today have no second or third use, and also that many people have a need for a compact, carry-along device with multiple uses at an economical price (Col 1, lines 40-47). One of the additional functions that Villa-Real implements is an automatic-dialing-after alert feature in which all persons targeted for alert are stored on a menu in the device and output to a display so that a number may be selected, and a call made (Col 11 lines 48-61), (ABSTRACT).

It would have been obvious to one of ordinary skill in the art at the time of this application to implement a feature in which all persons targeted for alert are stored on a menu in the device and output to a display so that a number may be selected, and a call made.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al (6477374) and further in view of Groff (4405839).

Shaffer discloses a communications system that follows these steps:

a. Claim 11a: Storing the name and last communication time data of a person to be called in a database (Col 8, lines 24-35), and (Col 12, lines 43-49).

b. Claim 11c: Determining whether the before-alert time interval has elapsed (Col 16, line 66 thru Col 17, line 19).

c. Claim 11d: After the time interval has elapsed, the system will alert the caller (or user), and the caller (or user) may try another phone call (Col 16, line 66 thru Col 17, line 1).

However, Shaffer fails to teach an alert inhibition controller that:

d. Claim 11b: Store an alert-inhibition time period in which alert is inhibited (Col 2, lines 21-30).

e. Claim 11d: After the time interval has elapsed, the system alerts the caller (or user) if the time of day falls out of the alert-inhibition time period, and the caller (or user) may try another phone call

f. Claim 11e: Inhibit an alert if it falls into the alert-inhibition period (Col 1 lines 50-55).

Groff teaches that a telephone subscriber desires to selectively silence the ringer of his telephone when he doesn't want to be disturbed. Based on this information, it would have been obvious to one of ordinary skill in the art at the time of this application to implement an alert inhibition controller so that it could silence the ringing without having to unplug the telephone (and risk forgetting to plug the phone back in) (Col 1, lines 11-43).

11. Claims 12-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al (6477374) and Groff (4405839) as applied to Claim 11, and further in view of Villa-Real (4481382).

a. Claim 12: Shaffer and Groff disclose applicant's claim 11, but do not mention that the time data is a last communication time of day which communication was made with a person to be called last.

Villa-Real teaches that communications equipment with the ability to provide an audio-visual alert system for calls to be made at specific times and dates can be a very useful tool for the professional as well as the general public. This system gives the advantage of allowing the user to schedule multiple phone calls without running the risk of forgetting them. In his reminder system, Villa-Real further specifies that the time data stored with each person's name is a last communication time of day which communication was made with a person to be called last (Col 4, lines 12-24).

It would have been obvious to one of ordinary skill in the art at the time of this application to provide the call reminder function in his communication system, and also that the stored time data for the reminder function is a last communication time of day which communication was made with a person to be called last.

b. Claim 13: Shaffer and Groff disclose applicant's claim 11, but do not disclose the exact method of alerting the user.

Villa-Real's system teaches a communications reminder system in which all alerts are performed by a speaker, or shown on a digital display. (Col 5, lines 60-64), (Col 1 lines 55-60).

It would have been obvious to one of ordinary skill in the art at the time of this application to provide an audio/visual alert to the user for a communications reminder system.

c. Claim 14: Groth additionally mentions that the alert-inhibition system may optionally inhibit only audio alerts in the telephone (Col 1 lines 50-55).

It would have been obvious to one of ordinary skill in the art at the time of this application that, during the alert-inhibition time, only the audible alarms would be silent and the display could still provide an alert to the user.

d. Claim 17: Shaffer and Groff disclose applicant's claim 11, but do not mention the feature where all persons targeted for alert are stored on a menu in the device and output to a display so that a number may be selected, and a call made.

Villa-Real teaches that many phones today have no second or third use, and also that many people have a need for a compact, carry-along device with multiple uses at an economical price (Col 1, lines 40-47). One of the additional functions that Villa-Real implements is an automatic-dialing-after alert feature in which all persons targeted for alert are stored on a menu in the device and output to a display so that a number may be selected, and a call made (Col 11 lines 48-61), (ABSTRACT).

It would have been obvious to one of ordinary skill in the art at the time of this application to implement a feature in which all persons targeted for alert are stored on a menu in the device and output to a display so that a number may be selected, and a call made.

12. Claim 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al (6477374), and further in view of Smith (5822400).

Shaffer discloses a communications system with a:

a. Claim 19a: Database that stores the name and time data of a person to be called in a database (Caller-ID) (Col 8, lines 24-35), and (Col 12, lines 43-49).

b. Claim 19b: Controller that determines that a time interval has elapsed without communication, then alerts the caller (or user)(Col 16, line 66 thru Col 17, line 19).

However Shaffer does not teach:

c. Claim 19a: divided the plurality of persons into a plurality of groups.

d. Claim 19b: determined the before-alert time interval for each group.

Smith (5822400) teaches that many businesses and customer service organizations utilize telephone systems that include the ability to process a large number of customer records by grouping them together into campaigns (Col 1, lines 11-36). It would have been obvious to one of ordinary skill in the art at the time of this application to divide the plurality of people into a plurality of groups and then determine the before-alert time interval for each group because this would gives the system the advantage of being able to process the grouped users in a batch and enter account records (such as the before-alert time interval) much more efficiently.

13. Claim 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer et al (6477374), and further in view of Groff (4405839).

Shaffer discloses a communications system with a:

a. Claim 20a: Database that stores the name and time data of a person to be called in a database (Caller-ID) (Col 8, lines 24-35), and (Col 12, lines 43-49).

b. Claim 20c: Controller that determines that a time interval has elapsed without communication, then alerts the caller (or user)(Col 16, line 66 thru Col 17, line 19).

However, Shaffer fails to teach an alert inhibition controller that can:

c. Claim 20b: Store an alert-inhibition time period in which alert is inhibited (Col 2, lines 21-30).

d. Claim 20c: Inhibit an alert if it falls into the alert-inhibition period (Col 1 lines 50-55).

Groff teaches that a telephone subscriber desires to selectively silence the ringer of his telephone when he doesn't want to be disturbed. Based on this information, it would have been obvious to one of ordinary skill in the art at the time of this application to implement an alert inhibition controller so that it could silence the ringing without having to unplug the telephone (and risk forgetting to plug the phone back in) (Col 1, lines 11-43).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Jamal whose telephone number is 703-305-3433. The examiner can normally be reached on M-F 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A Kuntz can be reached on 703-305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9315 for After Final communications.

AJ
July 8, 2003

DUC NGUYEN
PRIMARY EXAMINER